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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/587,116	06/02/2000	Steven C. Quay	18072-000600US	6790

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[REDACTED] EXAMINER

SMALL, ANDREA D SOUZA

[REDACTED] ART UNIT [REDACTED] PAPER NUMBER

1626

DATE MAILED: 06/12/2003

14

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	09/587,116	QUAY, STEVEN C.
	<b>Examiner</b>	<b>Art Unit</b>
	Andrea D Small	1626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 06 February 2003.
- 2a) This action is **FINAL**.      2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-3 and 5-27 is/are pending in the application.
- 4a) Of the above claim(s) 13-14 and parts of 1-3 ,5, 7-12 and 15-27 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) \_\_\_\_\_ is/are rejected.
- 7) Claim(s) 13-14 and parts of 1-3 ,5, 7-12 and 15-27 is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some \* c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_ .
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a)  The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

- |  |  |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                    | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ . |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)           | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ . | 6) <input type="checkbox"/> Other: _____ .                                   |

## DETAILED ACTION

### ***I. Applicants Response:***

(a) Applicants response filed 2/24/2003 has been received and entered as paper no. 13.

### ***II. Applicants Amendment:***

(a) Claim 6 has been cancelled.

(b) Claims 9-12, 21, 22, 25 and 26 have been amended. No new matter has been added.

(c) Pending Claims: 1-3, 5 and 7-27.

### ***III. Traversal of Restriction:***

**A. The Application has been restricted as follows: See office action of paper no. 7 and 12.**

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-12 and 15-27, drawn to products, where the X group is Oxygen
- II. Claims 1-12 and 15-27, drawn to products, where the X group is Sulfur.
- III. Claims 1-12 and 15-27, drawn to products, where the X group is Nitrogen.

Additionally, an election of species under the elected group was required. (See again paper no. 7). Applicants elected group I, and the species of compound 4, in figure 1. See office action of paper no. 12.

**B. The generic concept, which is inclusive of the elected species as identified in office action of paper no. 12 is as follows:**

Compound of claim 1, wherein:

X is O;

X1 is as claimed;

X2 is as claimed;

R2 is a member selected from reactive functional groups, alkyl groups terminally substituted with reactive functional groups and internally substituted with alkyl groups terminally

substituted with a reactive functional group wherein the reactive functional group is selected from -OR3, -NHR4, -COR5, -SH, and CH<sub>2</sub>X3, wherein

-OR3 is a member selected from hydroxy, alkyl sulfonate and aryl sulfonate groups;

R4 is H;

R5 is a member selected from X3 and -OR6, wherein R6 is as claimed; and

X3 is halogen.

**C. Non-elected Subject Matter:**

The subject matter of claims 13 and 14 and claims remaining subject matter of claims 1-12 and 15-27 stand withdrawn from consideration as being drawn to non-elected subject matter. 37 CFR 1.142(b). To wit, the subject matter of claims 1-12 and 15-27, wherein X is NH or S; X1 is as claimed; X2 is as claimed; R2 is a member selected from reactive functional groups, alkyl groups terminally substituted with reactive functional groups and internally substituted with alkyl groups terminally substituted with a reactive functional group wherein the reactive functional group is selected from -OR3, -NHR4, -COR5, -SH, and CH<sub>2</sub>X3, wherein -OR3 is a member selected from hydroxy, alkyl sulfonate and aryl sulfonate groups; R4 is H; R5 is a member selected from H, X3 and -OR6, wherein R6 is as claimed; and X3 is halogen **and** subject matter where X is O and R2 is member selected from reactive functional groups, alkyl groups terminally substituted with reactive functional groups and internally substituted with alkyl groups terminally substituted with a reactive functional group wherein the reactive functional group is selected from -COR5, - wherein R5 is a member selected from H, stands withdrawn as being drawn to non-elected subject matter. 37 CFR 1.142(b).

**D. Applicants Arguments:**

Applicants have asserted that the Examiner has withdrawn from consideration the species of formula I, claim 1 wherein X is S and X is NH impermissibly because under MPE 803.02, that if the Examiner has not found any reference that anticipates or renders obvious the elected species, then the examiner must extend the search of a Markush-type claim to either of the two non-elected species. Applicants have cited MPEP 803.02 to support their assertion. In a telephone conversation with Applicants representative, (see attached facsimile) Applicants also asserted that it is improper to restrict within a claim, the basis for their assertion may be found in *In re Weber*, 198 USPQ 328 (CCPA 1978). Further, Applicants asserted that in accordance with *Weber*, a restriction within the claim would prevent Applicant from having the entire invention examined. (See attached Interview Summary). This is not found persuasive because:

**E. Response to Arguments:**

First, restrictions within a claim or between claims under 35 USC 121 are permitted. The statute states that the office has the authority to restrict the application to a single independent and distinct invention, where two or more inventions are claimed in one application. The guide to establishing the restriction MPEP 803 states that this may be established by a two-prong test. First, establishing that the group is independent or distinct from the other groups and second, there must be a serious burden on the examiner if restriction is required. The instantly issued restriction is required under 35 USC 121, MPEP 803 and not under MPEP 803.02 as erroneously asserted by Applicant. In fact, nowhere in any of the previous office actions has the Examiner cited MPEP 803.02 as the basis for the restriction requirement as outlined. The sole basis for the restriction is 35 USC 121 and the fact that more than one independent or distinct invention is

being claimed. In this instance, the withdrawn subject matter is patentably distinct from the elected and examined subject matter in that Claim 1 has already been established as being generic where a number of distinct species are claimed thereto. See office action of paper no. 7. Each species differs one from the other in structure and element and have each acquired separate status in the art. For example, the furan moiety may be classified in class 549, subclass 200+; the tetrahydro thiophene moiety is classified in class 549, subclass 29; the pyrrolidine moiety is classified in class 548, subclass 541. The substituents on the ring also result in the compounds being classified in various classes and subclasses. For example, the acid moiety of the ring places the compound in class 562, subclass 400, while the carboxylic acid ester would place the compound in class 560, subclass 9+, etc. These distinct species may be included together in a generic claim where the number of species is reasonable and where there is NO serious burden on the examiner if restriction between these species is required. However, A serious burden does in fact exist. The grouping of the compounds where X is O is distinct from the non-elected grouping that containing the compounds where X is S or X is NH. The search required, both electronic and manual database, is separate that involves separate search considerations and search strategies. These searches are not co-extensive and the evaluation of the search results are divergent, so much so that a searching for a reference that would anticipate the one of the groups would not even render the non-elected invention obvious. Therefore, a serious burden would be placed on the examiner if restriction between these groupings were not required.

Second, *In re Weber* does not stand for the assertion that restrictions within a Markush claims is improper, rather the case deals with *rejection* of a claim as being an improper Markush claim under 35 USC 121. In fact, the concurring opinion text, Judge Rich asserted that

[D]ealing, as it does, with requirements for restriction, §121 says nothing whatever about the rejection of claims, a matter entirely separate from restriction. For one thing, rejections are appealable to the board and restriction requirements are not. Federico, op. cit. p. 34; 37 CFR §1.144.

On this appeal from the rejection of claims 1-6 we do not have before us a restriction requirement under §121. Such a requirement would not have been appealable to the board. We have before us an appeal from affirmance of a *rejection*.

Since the issue before us is a restriction under 35 USC 121 and not a rejection under said statutory provision, *Weber* is not controlling on the issues of restriction. Contrary to Applicants assertion in the telephone conversation, that in accordance with *Weber*, a restriction within the claim would prevent Applicant from having the entire invention examined. The entire scope of the claimed subject matter will, in fact, be eventually be examined, either as elected subject matter in this application or as elected subject matter in divisional applications. The basis of the withdrawal of the subject matter being claimed is 37 CFR 1.142(b), which retains Applicants right to file divisional applications to the non-elected inventions, whereas *Weber* dealt with the subject matter being withdrawn as a result of a rejection of the claims as being improper Markush claims. Since the *Weber* case is not on point with the issues present in this case, the Applicant will eventually have their claims examined in their entirety.

For these reasons and the reasons of record, the restriction requirement as stated is proper made FINAL.

(d) Rejections under 35 USC 112, second:

Upon reconsideration and in light of Applicants arguments, the rejections under this statute have been withdrawn.

***III. Objections:***

Claims 1-3, 5, 7-12 and 15-27 and claims 13-14 are objected to as containing non-elected subject matter and would appear allowable if limited solely to the generic concept identified in office action of paper no. 12. 37 CFR 1.142(b).

***IV. State of the Art:***

*Sohda, et al is cited to indicate the state of the Art, where it discloses compounds where Applicants corresponding X is O; X1 is O; R1 is hydrogen and R2 is alkyl substituted by COR5, where R5 is H. The reference does not anticipate or render obvious the generic concept as identified in office action of paper no. 12, which is the elected group, as the instantly claimed generic group does not include where R5 is hydrogen, rather R5 only includes X3 and OR6.*

***VI. Finality:***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

**VII. Contacts:**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrea D. Small, whose telephone number is (703) 305-0811. The examiner can normally be reached on Monday-Thursday from 8:30 AM - 7:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Joseph K. McKane, can be reached at (703) 308-4537. The Unofficial fax phone number for this Group is (703) 308-7921. The Official fax phone numbers for this Group are (703) 308-4556 or 305-3592.

When filing a FAX in Technology Center 1600, please indicate in the Header (upper right) "Official" for papers that are to be entered into the file, and "Unofficial" for draft documents and other communications with the PTO that are not for entry into the file of the application. This will expedite processing of your papers.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [Joseph.McKane@uspto.gov]. All Internet e-mail communications will be made of record in the application file. PTO employees will not communicate with applicant via Internet e-mail where sensitive data will be exchanged or where there exists a possibility that sensitive data could be identified unless there is of record an express waiver of the confidentiality requirements under 35 U.S.C. 122 by the applicant. See the Interim Internet Usage Policy published by the Patent and Trademark Office Official Gazette on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist, whose telephone number is (703) 308-1234

Andrea D. Small, Esq.  
June 6, 2003

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